

Amendment to the Drawings

The attached Replacement Sheet of drawings includes changes to FIG. 4. In FIG. 4, the reference numeral "23" has been changed to "45", representative of the luminaire housing.

Attachment: Replacement Sheet
Annotated Sheet Showing Changes

REMARKS

By this amendment, Figure 4, the title, the abstract, and claims 1, 4, 5 and 9 have been amended. Claims 1-9 remain in the application. Support for the amendments to the claims can be found the specification and drawings. No new matter has been added. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, and allowance of the application, as amended, is respectfully requested.

The Drawings

The drawings stand objected to as failing to comply with 37 CFR 1.84(p)(4) because the reference characters "36" and "39" have both been used to designate "base." Applicant respectfully traverses this objection for at least the following reason. As understood from the specification on page 5, lines 4-5, and FIG. 2, "[t]he [light-refracting] element 35 has a **base 36**, see Fig. 2, facing the light emission window 15 ..." [Emphasis added]. As further understood from the specification on page 5, lines 12-15, and FIG. 2, "[t]he [light-refracting] element 35 is composed of a number of refracting *sub-elements 38*, each [sub-element 38] having a **base 39** facing the light emission window 15 ..." . In the embodiment shown, the refracting element 35 has five *sub-elements 38*." [Emphasis added]. Thus, base 36 refers to the base of light-refracting element 35. Base 39 refers to the base of a corresponding refractive sub-element 38. In Figure 2, the base 36 of the refractive element 35 is coincident with the base 39 of the refractive sub-element 38 closest to the light emission window 15. Accordingly, the objection of the drawings should be withdrawn.

The drawings stand objected to as failing to comply with 37 CFR 1.84(p)(4) because the reference characters "37" and "40" have both been used to designate "top." Applicant respectfully traverses this objection for at least the following reason. As understood from the specification on page 5, lines 4-5, and FIG. 2, "[t]he [light-

[refracting] element 35 has ... a **top 37** remote from the light emission window 15."

[Emphasis added]. As further understood from the specification on page 5, lines 12-15, and FIG. 2, "[t]he [light-refracting] element 35 is composed of a number of refracting sub-elements 38, each [sub-element 38] having ... a **top 40** remote from the light emission window 15, cf. also Fig. 2. In the embodiment shown, the refracting element 35 has five sub-elements 38." [Emphasis added]. Thus, top 37 refers to the top of light-refracting element 35. Top 40 refers to the top of a corresponding refractive sub-element 38. In Figure 2, the top 37 of the refractive element 35 is coincident with the top 40 of the refractive sub-element 38 furthest from the light emission window 15. Accordingly, the objection of the drawings should be withdrawn.

The drawings stand objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 23. By this amendment, FIG. 4 has been amended to include the correct reference numeral 45, which replaces the erroneous reference numeral 23. Accordingly, objection of the drawings is now believed overcome.

The drawings stand objected to because in Figure 4 reference numeral 11 is shown; however, the Examiner is unclear how, based on the view of the figure, it designates the plane of symmetry. As understood from the specification on page 4, lines 23-31, and Figure 1, the plane of symmetry 11 comprises a central plane, wherein the central plane of the cross-section divides the luminaire into two substantially equal parts. That is, in Figure 1, the plane of symmetry 11 extends into and out-of the plane of the drawing (or page), in which the left-hand portion of the luminaire is substantially equal to the right-hand portion of the luminaire. With respect to the plane of symmetry 11 of Figure 4, as understood from the specification on page 6, lines 8-9, the plane of the drawing in Figure 4 coincides with the plane of symmetry 11. In other words, the plane of symmetry of the illustration of Figure 4 is the plane of the drawing, wherein a first half-portion of the luminaire of Figure 4 is above the plane (page) of the drawing (not shown), and the other substantially equal half-portion of the luminaire of Figure 4 is

below the plane (page) of the drawing (shown). In other words, the substantially equal portions of Figure 1 are (i) to the left and (ii) to the right of the plane of symmetry 11; whereas, for the two substantially equal portions of Figure 4, (i) the first portion is **above** the plane of symmetry 11 and (ii) the other portion is **below** the plane of symmetry 11. In Figure 4, the portion below the plane of symmetry is shown. Accordingly, the objection of the drawings should be withdrawn.

Objection to the Specification

The abstract of the disclosure stands objected to as not having been submitted on its own sheet of paper without the rest of the WO information. By this amendment, the abstract has been amended and presented on its own sheet of paper. Accordingly, the objection to the specification has been overcome.

The disclosure stands objected to for lack of headings between each of the sections of the specification. Applicant respectfully declines the invitation to add headings between the sections of the specification as they are not required in accordance with MPEP §608.01(a). Withdrawal of the objection to the disclosure is respectfully requested.

The disclosure stands objected to because of the following informalities: Reference numeral 23 in Figure 4 is not in the specification. As noted herein, Figure 4 has been amended to replace the reference numeral 23 with the correct reference numeral 45, thus rendering the objection to the specification now moot. Withdrawal of the objection to the specification is respectfully requested.

The specification stands objected to in that the title of the invention is not descriptive. By this amendment, the title of the application has been amended to be indicative of the invention to which the claims are directed. Accordingly, the objection to the specification is now believed overcome and withdrawal of the objection is respectfully requested.

Rejection under 35 U.S.C. §103

Claim 1 recites a luminaire suitable for under canopy lighting, comprising:

- a concave reflector (10) with a plane of symmetry (11) and defining a cavity (12);
- a light emission window (15) tangent to the reflector (10), transverse to the plane of symmetry (11), and having first edges (16) along the plane of symmetry (11);
- holding means (20) for accommodating an electric lamp L in the cavity (12) of the reflector (10), with an elongate light source Ls of said lamp L transverse to the plane of symmetry (11);
- a set of strips (25) adjacent the first edges (16), extending substantially from the light emission window (15) into the cavity (12), said strips being light-diffusing, wherein the strips create a cut-off angle β with respect to the light emission window (15) within which no light is emitted directly from the lamp;
- a light-transmitting hood (30) covering the light emission window (15), said hood (30) having first walls (31) extending substantially away from the first edges (16); and
- a light-refracting element (35) disposed within a region of the cut-off angle β and along at least one of the first walls (31) of the light-transmitting hood (30), the element (35) having a base (36) facing the light emission window (15) and a top (37) remote from the light emission window (15), wherein the light-refracting element is configured to cause light emitted from said lamp L that is diffusely reflected from one of the strips at an opposite side of the plane of symmetry to emanate within an angle of up to 5^0 to the light emission window (15).

Support for the amendments to claim 1, can be found in the specification at least on page 5, lines 1-10; and FIG. 1.

Claims 1-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Entrop et al. (US 5,564,820) in view of Shadwick (US 4,462,068). With respect to claim 1, Applicant respectfully traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claim 1.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for at least the following, mutually exclusive, reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The Entrop and Shadwick patents cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ...
(Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither Entrop nor Shadwick teaches a light-refracting element disposed (i) within a region of the cut-off angle β and (ii) along at least one of the first walls of the light-transmitting hood ... configured to cause light

emitted from said lamp L that is *diffusely reflected* from one of the strips at an opposite side of the plane of symmetry to emanate within an angle of up to 5° to the light emission window ... as is claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness

In the present case the Shadwick reference, by providing a generally vertical second lens surface 70 on a first lens surface 60 around a periphery thereof, wherein the second lens surface 70 serves to diffuse a beam of light outwardly, is directed to a luminaire in which light is directly emitted from a lamp of the luminaire in a manner to provide a uniform distribution illumination pattern. Thus, this system clearly teaches away from claim 1, recited above.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason alone, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

3. The references are not properly combinable if their intended function is destroyed

It is clear that the Entrop and Shadwick patents are not properly combinable since, if combined, their intended function is destroyed. More particularly, if the Entrop patent were modified, as required by the rejection, it would be rendered inoperable for its intended purpose because high brightness of the light would be diffused outwardly, the high brightness of light which is intended to be blocked, and thus would not prevent an observer from looking into the lamp or from observing high brightnesses coming from the lamp in the luminaire at an angle in excess of an angle α (See Entrop at Col. 2, lines 45-47; and FIG. 1).

Thus, since this modification of the Entrop patent clearly destroys the purpose or function of the invention disclosed in the patent, one of ordinary skill in the art would not have found a reason to make the claimed modification.

Thus, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

4. The Combination of References is Improper

Assuming, arguendo, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why the Entrop and Shadwick patents cannot be applied to reject claim 1 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made..... The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Here, neither Entrop nor Shadwick teaches, or even suggests, the desirability of the combination since neither teaches the specific arrangement and location of the light refracting element and the light-transmitting hood as specified above and as claimed in claim 1.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Dependent claims 2-8 depend from and further limit independent claim 1 and therefore are allowable as well. Claim 9 has been amended similarly as with respect to the amendment to claim 1. Claim 9 is thus believed allowable for the similar reasons stated herein with respect to claim 1 for overcoming the rejection. The 35 U.S.C. § 103(a) rejection thereof has now been overcome.

Conclusion

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claims 1 and 9 are in condition for allowance. Dependent claims 2-8 depend from and further limit independent claim 1 and therefore are allowable as well.

The amendments herein are fully supported by the original specification and drawings, therefore, no new matter is introduced. An early formal notice of allowance of claims 1-9 is requested.

Respectfully submitted,

Michael J. Balconi-Lamica
Michael J. Balconi-Lamica
Registration No. 34,291
for Frank Keegan, Reg. No. 50,145

Dated: 1/22/07

Philips Intellectual Property & Standards
345 Scarborough Road
Briarcliff Manor, New York 10510
Telephone: 914-333-9669
Facsimile: 914-332-0615
File: NL031010US

ATTACHMENTS

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